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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/144,851	09/01/98	KATO	Y KATO=15

001444 IM22/0220
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EXAMINER

SHERRER, C

ART UNIT	PAPER NUMBER
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1761

21

DATE MAILED: 02/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/144,851

Applicant(s)

Kato et al

Examiner

Curtis E. Sherrer

Group Art Unit
1761



☒ Responsive to communication(s) filed on Dec 14, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-31 is/are pending in the application

Of the above, claim(s) 11 and 20 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10, 12-19, and 21-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1761

Part III DETAILED ACTION

Election/Restriction

1. This application contains claims 11 and 20 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-10, and 12-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As stated in the last Office Action, Claim 1 has been amended by inserting a limitation directed to the exclusion of an alkaline agent from the instantly claimed method. Dependent claims containing a limitation to an acid reduction treatment as found in Claims and the specification does not provide a basis for reducing the acidity except by using an alkaline agent (as now claimed in Claim 1).

Art Unit: 1761

4. In a new rejection, Claim 31 contains the limitation of sterilizing and then filtering, and this two step limitation was not found in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-10 and 13-19 and 21-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The claims are indefinite because the scope of the phrase "alkaline agent" is unknown. For example, it is not clear if the phrase excludes alkaline compounds naturally present in the juice or alkaline agents that might be added as to adjust the pH or as bacterial nutrients, such as ammonium salts (see page 8, top). A review of the specification provides no guidance in determining the scope of the phrase.

In response, Applicants state that an alkaline agent can be one that raises the pH of solution. This would include weak acid solutions that are added to strong acid solutions, i.e., the pH of the strong solution would go up. Therefore, it is still considered indefinite and not clear that this is the scope as the specification does not provide basis for such an interpretation.

7. Again, Claims 14-19 are indefinite because it is unclear how one can perform the claimed process of reducing the acidity except by using an alkaline agent as excluded claimed in Claim

1.

Art Unit: 1761

8. Claim 21 is indefinite because it is unclear if the citric acid reduction step of step (I) and (ii), refer to the citric acid reduction step of (2). It is assumed for the instant rejections, that it does not. i.e., Claim 21 requires the citric acid reduction in all steps.

9. There is no antecedent basis for the phrases "the middle stage" and "the last stage," as found in Claim 29. Further, the scope of these "stages" is unknown.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seike in view of Jackson (Wine Science, pp. 229 and 279-80).

12. Seike teaches the production of vinegar from citrus fruits, such as lemons, whereby the fruit juice is clarified with an enzyme, acid adjusted, sterilized, cooled, alcohol is added, it is inoculated with acetic acid bacteria and fermented, matured, filtered and juice from unripe fruit is added. It is noted that limitations (2) and (3) and claims that further limit these members of the Markush group have not been treated.

Art Unit: 1761

13. Seike teaches that cited above, including the modification of the pH, e.g., lowering the acidity, but does not specifically teach the citric acid reduction treatment. Jackson teaches the reduction of grape juice and/or wine acidity by means of precipitation, e.g., calcium carbonate addition, and column ion exchange. It would have been obvious to those of ordinary skill in the art to deacidify the fruit juices of Seike in order to modify the flavor of the final product.

14. Applicants' attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coercion or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

15. While the reference cited above do not disclose the amounts of the fruit juice used, the specifically claimed citric acid content it is considered that in view of the court's holding in *In re Levin* it would have been obvious to those in the vinegar processing industry to modify these parameters as they are result effective variables that are commonly optimized.

Art Unit: 1761

16. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seike in view of Jackson and in further view of Castillon et al (U.S. Pat. No. 5,415,775).

17. Seike in view of Jackson teaches that cited above but neither reference teaches the use of ultrafiltration in connection with vinegar. While such a limitation is considered to be notoriously well known in the art, Castillon et al teach that ultrafiltration membranes are commonly used to purify vinegar (col. 5, lines 34-39) and therefore it would have been obvious to those of ordinary skill in the art to ultrafilter the vinegar of Seike so as to increase its purity.

Conclusion

18. No claim is allowed.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30. The **fax phone number** for this Group is (703)-305-3602.

20. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Curtis E. Sherrer
Primary Examiner
February 16, 2001